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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROY J. MANKOVITZ

Appeal 2009-010892
Application 09/292,275¹
Technology Center 2400

Before MARC S. HOFF, ELENI MANTIS MERCADER, and
CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The real party in interest is Bismuth Landless Wire L.L.C.

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a Final Rejection of claims 78-82, 92-110, 117-130, 132-137, 160, and 161.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Appellant's invention concerns a method and system for providing supplemental information about a broadcast. When a user wishes to obtain supplemental information concerning a received program, the user presses a button, which causes the station, day, and time data to be stored in a memory. This stored data can later be downloaded to the central processor station for accessing the supplemental information associated with the stored data (Spec. 8-9).

Claim 78 is exemplary of the claims on appeal:

78. A method of providing supplemental information about a broadcast, the method comprising:

receiving, at a portable, hand-held electronic device, a request for supplemental information associated with the broadcast, wherein the hand-held electronic device includes a memory, a communications interface, and a clock;

storing, in the memory, time-of-day information corresponding to a time at which the request is received, wherein the time-of-day information is provided by the clock;

establishing a connection to a remote database through the communications interface;

transferring the time-of-day information stored in the memory to the remote database;

² Claims 1-58 and 131 have been cancelled. Claims 59-77, 83-91, 111-116, 138-159, and 162-165 stand withdrawn as directed to nonelected inventions.

receiving the supplemental information, associated with the broadcast and identified through correlation of the time of day information to the broadcast, from the remote database; and

communicating the supplemental information using the hand-held electronic device.

The Examiner relies upon the following prior art in rejecting the claims on appeal:

Welsh	US 4,955,070	Sep. 4, 1990
Croquet	US 5,155,762	Oct. 13, 1992
Kiefl	US 5,382,970	Jan. 17, 1995
Goldstein	US 5,410,326	Apr. 25, 1995
Palmer	US 5,438,355	Aug. 1, 1995
Chan	US 5,553,123	Sep. 3, 1996
Atcheson	US 5,583,763	Dec. 10, 1996
Dedrick	US 5,724,521	Mar. 3, 1998
Fenner	US 5,860,136	Jan. 12, 1999

Claims 78-82, 92, 93, 95, 96, 102-104, 106-110, 117-122, 124-130, 133-137, 160, and 161 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Palmer in view of Kiefl and Goldstein.

Claims 94, 105, 123, and 132 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Palmer in view of Kiefl, Goldstein, and Welsh.

Claims 97-101 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Palmer in view of Kiefl, Goldstein, and Atcheson.

Throughout this decision, we make reference to the Appeal Brief ("App. Br.," filed Sep. 15, 2008) and the Examiner's Answer ("Ans.," mailed Nov. 24, 2008) for their respective details.

ISSUES

With respect to independent claims 78, 92, and 117, Appellant argues, *inter alia*, that Kiefl does not meet the limitation of storing, in the memory, time-of-day information corresponding to a time at which the request is received because Kiefl teaches not storing data regarding short duration (e.g., under five seconds) viewing of a particular channel. Appellant further argues that Goldstein does not teach the concept of supplemental information about a broadcast (App. Br. 12).

With respect to claim 95, Appellant argues that Dedrick, cited by the Examiner in support of Official Notice that memory removability is well known, does not teach memory removable for transport to a different location for communicating the time-of-day information to the database (App. Br. 16).

With respect to claim 103, Appellant argues that Palmer teaches communicating geographical data, but not identification information, to the database along with the request for supplemental information (App. Br. 17).

With respect to claims 104 and 161, Appellant argues that Palmer fails to teach analyzing identification information to determine the number of requests for the supplemental information (App. Br. 18).

With respect to claims 107 and 134, Appellant argues that Fenner, cited by the Examiner to support Official Notice that data erasure is well known, does not teach erasing time-of-day information from the memory in response to a request from the database (App. Br. 19).

With respect to claims 109 and 136, Appellant argues that Palmer does not teach including a copy of the broadcast in audio, video, or text format (App. Br. 19).

With respect to claim 94, Appellant argues that Welsh does not teach communicating station identification information along with time-of-day information (App. Br. 21).

Appellant's contentions present us with the following issues:

1. Does the combination of Palmer, Kiefl, and Goldstein teach or fairly suggest a method of providing supplemental information about a broadcast?

2. Does the combination of Palmer, Kiefl, and Goldstein teach or fairly suggest storing, in the memory, time-of-day information corresponding to a time at which a request is received?

3. Does the combination of Palmer, Kiefl, and Goldstein, as well as the Examiner's Official Notice (that it is known to move data from one computer to another using a removable memory device), teach or fairly suggest a memory that is removable from the device for transport to a different location for communicating the time-of-day information to the database?

4. Does the combination of Palmer, Kiefl, and Goldstein teach or fairly suggest a controller configured to communicate the identification information to the database along with the request for supplemental information?

5. Does the combination of Palmer, Kiefl, and Goldstein teach or fairly suggest processor means for analyzing the identification information to determine a number of requests for the supplemental information?

6. Does the combination of Palmer, Kiefl, and Goldstein, as well as the Examiner's Official Notice that it is known to erase data from memory,

teach or fairly suggest processor means for erasing the time-of-day information from the memory in response to a request from the database?

7. Does the combination of Palmer, Kiefl, and Goldstein teach or fairly suggest that the supplemental information includes a copy of the broadcast in an audio format, a video format, or a text format?

8. Does the combination of Palmer, Kiefl, Goldstein, and Welsh teach or fairly suggest that station identification information is communicated to the database along with the time-of-day information to identify the supplemental information to be communicated to the device?

FINDINGS OF FACT

Palmer

1. Palmer teaches that database 20 contains a plurality of console identification codes (CIC) uniquely identifying each of the plurality of consoles 14 in the field and associated console data including, for example, where each console is geographically located, billing information, security numbers, phone numbers, viewer habit data, request history, local mailing address, credit card numbers, etc. (col. 3, ll. 33-40).

2. Palmer teaches that “[i]t is also possible to provide broadcasters and advertisers detailed data regarding geographical locations of users, which channels were watched and at what times. This information will be determined by analyzing data gathered at the time of each viewer response and stored in database 20” (col. 4, ll. 31-37).

3. Palmer teaches that each program identification code (PIC) includes information regarding the particular program identified by the PIC, such as purchase receipts, details regarding the products and services advertised in

the commercial, or any other information an advertiser wishes to convey to the viewer via a fax transmission (col. 3, ll. 26-32).

Kiefl

4. Kiefl teaches a channel detector that provides a signal to microprocessor 23 representing the channel of record and microprocessor 23 stores the information in a location in a memory 28, together with data on the beginning time and end time at which the channel was selected by remote control 10 (col. 6, ll. 38-43).

5. Kiefl teaches that to avoid recording times for each channel selected when a viewer is scanning through a number of channels, it is desirable not to provide a record of channels selected for less than a preset short time, say for example, five seconds or less. With this exception, the data is stored in memory 28 (col. 6, ll. 47-50).

PRINCIPLES OF LAW

Section 103(a) forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in

any particular case, the [*Graham*] factors continue to define the inquiry that controls.”).

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997).

ANALYSIS

CLAIMS 78-82, 92, 93, 96, 102, 106, 108, 110, 117-122, 124-130, 133, 135, 137, AND 160

We select claim 78 as representative of this group of claims, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii).

Appellant argues that Kiefl does not teach “storing, in the memory, time-of-day information corresponding to a time at which the request is received.” According to Appellant, Kiefl stores data on the beginning time and end time at which the channel was selected by remote control 10, but does not store such data with regard to channels selected for less than a preset short time (e.g., five seconds) (App. Br. 10-11; FF 4, 5). Thus, Appellant argues that Kiefl’s non-storage of such short intervals teach away from the claimed invention and would make the claimed invention inoperable (App. Br. 11).

Appellant’s argument is not persuasive. Representative claim 78 recites “receiving . . . a request for supplemental information associated with the broadcast,” and “storing, in the memory, time-of-day information corresponding to a time at which the request is received.” We agree with the Examiner’s finding that Palmer teaches receiving a request for supplemental information and responding to said request. We further agree with the

Examiner that Palmer lacks only the storage of *time-of-day information*. We also note that the claim does not recite receiving a plurality of such requests and storing every single request in memory. Kiefl teaches the recognition of a plurality of remote control key-presses, and the storage in memory of the time and channel of that (smaller) plurality not associated with viewing a television channel for less than five seconds (FF 4, 5). Kiefl thus teaches storing time-of-day information corresponding to *a* (i.e., singular) time at which *a* (i.e., singular) request is received, as the representative claim recites.

Appellant's argument that Goldstein fails to teach supplemental information about a broadcast is not persuasive to establish error. We agree with the Examiner's finding that Palmer teaches this limitation (col. 4, ll. 10-37).

Because the combination of Palmer, Kiefl, and Goldstein teaches all the limitations of the claimed invention, we conclude that the Examiner did not err in rejecting claims 78-82, 92, 93, 96, 102, 106, 108, 110, 117-122, 124-130, 133, 135, 137, and 160 as being unpatentable under § 103. We will sustain the Examiner's rejection.

CLAIM 95

Appellant's argument that the Examiner erred because Dedrick does not teach memory removable from a device for transport to a different location for communicating time-of-day information to the database (App. Br. 16) is not persuasive.

The Examiner took Official Notice that "the use of removable memory devices is notoriously well known in the art" and cited Dedrick in

support of that proposition (Ans. 11). Dedrick need not teach the exact limitations of the claim at issue for the Examiner's proposition to be correct.

Appellant's argument does not demonstrate any error in the Examiner's position. Accordingly, we will sustain the § 103 rejection of claim 95.

CLAIM 103

Appellant's argument that Palmer does not teach communicating identification information to the database is not persuasive (App. Br. 17). We agree with the Examiner's finding that Palmer teaches identification information, in the form of CICs that are associated with each PIC (Ans. 28; FF 1). We will sustain the Examiner's rejection of claim 103 as unpatentable over Palmer in view of Kiefl and Goldstein.

CLAIMS 104 AND 161

Appellant's argument that Palmer's teaching of geographical and channel data does not meet "analyzing the identification information to determine a number of requests for the supplemental information" (App. Br. 18) is not persuasive.

Palmer teaches that "[i]t is also possible to provide broadcasters and advertisers detailed data regarding geographical locations of users, which channels were watched and at what times. This information will be determined by analyzing data gathered at the time of each viewer response and stored in database 20" (FF 2). We agree with the Examiner's finding that because Palmer teaches transmitting CICs along with PICs when a viewer presses a response button, Palmer thus teaches analyzing *identification* information (CICs), to determine the *number* of requests (via said data gathering).

Therefore, we find that the Examiner did not err in rejecting claims 104 and 161, and we will sustain the § 103 rejection.

CLAIMS 107 AND 134

Appellant argues that the Examiner erred in rejecting these claims because the reference the Examiner cited to support the taking of Official Notice (Fenner) fails to teach or suggest erasing time-of-day information in response to a request from the database (App. Br. 18-19).

We are not persuaded by Appellant's argument. The Examiner took Official Notice that "means for erasing stored data from memory is notoriously well known in the art" (Ans. 13). The Examiner's conclusion that the claimed invention would have been obvious over Palmer, Kiefl, and Goldstein, given the fact noticed, is not refuted by the absence in Fenner of the precise "processor means" recited in the claim.

Because Appellant has not established error in the Examiner's § 103 rejection of claims 107 and 134, we will sustain the rejection.

CLAIMS 109 AND 136

The Examiner finds that Palmer teaches that the provided supplemental information includes a copy of the broadcast (Ans. 15). We do not agree with the Examiner's finding. Palmer teaches that the "unique program data" to be conveyed to the viewer via facsimile transmission, upon the viewer's request, includes "purchase receipts, details regarding the products and services advertised in the commercial, or any other information an advertiser wishes to convey" (FF 3). Palmer therefore does not teach providing "a copy of the broadcast in an audio format, a video format, or a text format" as the claims require.

Because the combination of Palmer, Kiefl, and Goldstein does not teach or fairly suggest all the elements of claims 109 and 136, we will not sustain the Examiner's § 103 rejection of these claims.

CLAIM 94

Appellant argues that the Examiner erred in rejecting claim 94, which depends from claim 92, because Welsh fails to teach or suggest station identification information communicated to the database along with the time-of-day information to identify the supplemental information (App. Br. 21).

We do not find Appellant's argument persuasive. As discussed *supra*, we find that the combination of Palmer and Kiefl teaches a system for providing supplemental information about a broadcast, including storing time-of-day information corresponding to a time at which a request for the supplemental information is received. We agree with the Examiner's finding that Welsh derives station identification information, which is reported back to a central database (Ans. 21). We further note that the Examiner relies on Kiefl, rather than Welsh, to teach communicating time-of-day information (Ans. 4).

We therefore find that the Examiner did not err in rejecting claim 94. We will sustain the § 103 rejection.

CLAIMS 105, 123, AND 132

Appellant argues that Welsh does not remedy the deficiencies of Palmer, Kiefl, and Goldstein (App. Br. 20). Since we are unpersuaded, *supra*, that the references are deficient in teaching or suggesting the claim limitations, we will sustain the § 103 rejection of claims 105, 123, and 132,

for the same reasons expressed *supra* with respect to independent claims 92 and 117.

CLAIMS 97-101

Appellant argues that Atcheson fails to remedy the deficiencies of the combination of Palmer, Kiefl, and Goldstein. Because we do not agree with Appellant that such deficiencies exist, we will sustain the rejection of claims 97-101, for the reasons expressed *supra* with respect to independent claim 92.

CONCLUSIONS

1. The combination of Palmer, Kiefl, and Goldstein teaches a method of providing supplemental information about a broadcast.

2. The combination of Palmer, Kiefl, and Goldstein fairly suggests storing, in the memory, time-of-day information corresponding to a time at which a request is received.

3. The combination of Palmer, Kiefl, and Goldstein, as well as the Examiner's Official Notice (that it is known to move data from one computer to another using a removable memory device) fairly suggests a memory that is removable from the device for transport to a different location for communicating the time-of-day information to the database.

4. The combination of Palmer, Kiefl, and Goldstein teaches a controller configured to communicate the identification information to the database along with the request for supplemental information.

5. The combination of Palmer, Kiefl, and Goldstein teaches processor means for analyzing the identification information to determine a number of requests for the supplemental information.

6. The combination of Palmer, Kiefl, and Goldstein, as well as the Examiner's Official Notice that it is known to erase data from memory, fairly suggests processor means for erasing the time-of-day information from the memory in response to a request from the database.

7. The combination of Palmer, Kiefl, and Goldstein does not teach or fairly suggest that the supplemental information includes a copy of the broadcast in an audio format, a video format, or a text format.

8. The combination of Palmer, Kiefl, Goldstein, and Welsh fairly suggests that station identification information is communicated to the database along with the time-of-day information to identify the supplemental information to be communicated to the device.

ORDER

The Examiner's rejections of claims 78-82, 92-108, 110, 117-130, 132-135, 137, 160, and 161 are affirmed. The Examiner's rejection of claims 109 and 136 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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